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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/597,019	07/06/2006	Donald R. Wellnitz	PHUS040031US2	1061

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EXAMINER
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BRYANT, MICHAEL C

ART UNIT	PAPER NUMBER
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2884

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03/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/597,019	<b>Applicant(s)</b> WELLNITZ, DONALD R.	
	<b>Examiner</b> CASEY BRYANT	<b>Art Unit</b> 2884	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 July 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/6/06</u> .  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The IDS filed 7/6/2006 has been considered.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the International Bureau on 1/5/2005. It is noted, however, that applicant has not filed a certified copy of the PCT/IB05/50043 application as required by 35 U.S.C. 119(b).

### ***Preliminary Amendment***

3. The preliminary amendment filed 7/6/2006 has been entered. Claims 1, 9, 17 and 21 have been amended. Claim 8 has been cancelled. No new claims have been added. Thus, claims 1-7 and 9-21 remain pending.

### ***Claim Objections***

4. Claim 14 is objected to because of the following informalities: the claim fails to end in a period. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-7 and 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The instant claims fail to meet the qualifications of a 'process' under 35 USC § 101, as clarified in *In re Bilski*, 545 F.3d 943, 88 USPQ2d 1385 (Fed. Cir. 2008). *Bilski* clarifies the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state of thing. Claims 1-7 and 9-16 fail the machine-or-transformation test.

Regarding the "machine" test, claims 1-7 and 9-16 fail to disclose the structure for performing steps of "digitally sampling...", "selecting a subset...", "determining a correction factor..." and "applying the correction factor...".

Regarding the "transformation" test, claims 1-7 and 9-16 fail to disclose a transformation of state in "generat[ing] a corrected integral value", which amounts to simply generating data.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-7, 17, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by **Cooke et al. (US 6,603,125 B1)**.

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Regarding claim 1, Cooke discloses a method (Fig. 3) comprising: digitally sampling an analog pulse at a plurality of intervals to generate a set of digital samples **A5** (Fig. 5; col. 6, lines 45-49); determining an integral from the samples in the set **B3** (col. 6, lines 65-66); selecting a subset of the samples **B6** (col. 7, lines 22-24); determining a correction factor corresponding to the subset of samples **C2** (col. 7, lines 39-43); and applying the correction factor to the integral to generate a corrected integral value **C3-C4** (col. 8, lines 22-35).

Regarding claim 2, Cooke discloses converting a photon of radiation into a scintillation and converting the scintillation into the analog pulse (Fig. 1; col. 5, lines 43-52).

Regarding claim 3, Cooke discloses smoothing the analog curve (col. 9, line 66-col. 10, line 2).

Regarding claim 4, Cooke discloses the digital sampling occurring at uniform time intervals (Fig. 5; col. 6, lines 45-49).

Regarding claim 5, Cooke discloses at least four samples in the set of digital samples (Fig. 5).

Regarding claim 6, Cooke discloses the integral including summing the samples in the set (col. 6, lines 45-52).

Regarding claim 7, Cooke discloses selecting the subset includes selecting the pulses (and their respective samples) from nineteen arranged sensors (col. 7, lines 22-48).

Regarding claim 11, Cooke discloses determining a state time of a pulse **B1** (Fig. 3).

Regarding claim 17, Cooke discloses a camera **10** comprising at least one detector head 12 and a processor **26** capable of integrating the pulses (col. 5, lines 42-66). Apparatus claims cover what a device is, not what a device does. An invention need not operate differently than the prior art to be patentable, but need only *be* (unobviously) different. Therefore, the phrase beginning “*item x* which performs *task y...*” has not been given patentable weight. To be given patentable weight in an apparatus claim, a functional limitation must be described in terms of the structure of the device. For example, an apparatus whose functional characteristics are limiting can be “configured to” perform a specific function. See e.g. *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1390-91, 7 USPQ2d 1222, 1224-25 (Fed. Cir.), cert. Denied, -- U.S. --, 109 S. Ct. 395 (1988); *Panduit Corp. v. Dennison Mfg. Co.*, 774 F. 2d 1082, 1098, 227 USPQ 337, 348 (Fed. Cir. 1985), vacated, 475 U.S. 809 [229 USPQ 478] (1986), on remand, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), cert. Denied, 481 U.S. 1052 (1987). *Hewlett-Packard Co. v. Bausch & Lomb, Inc.*, 15 USPQ2d 1525 (Fed. Cir. 1990).

It is further noted that an *item x* “for performing *task y...*” need only be capable of performing the task and need not necessarily be disclosed.

Finally, it is noted that actions within a processor which are carried out do not describe a structural limitation, but describe a method of using the processor. Accordingly, it has been held that the manner or method in which an apparatus is to be

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utilized is not germane to the issue of patentability of the apparatus itself. *In re Casey* 370 F.2d 576, 152 USPQ 235 (CCPA 1967). Therefore, the “action” limitations have not been given patentable weight and claim 17 is disclosed by Cooke.

Regarding claim 20, Cooke discloses a system comprising an A/D converter **24** capable of sampling the pulse at intervals of time to generate a set of digital samples (Fig. 1; col. 6, lines 33-37), a correction table (col. 9, lines 32-35), and a processor **26** capable of calculating an integral of the pulse from the digital values (col. 6, lines 65-66). As detailed above in the rejection of claim 17, the phrase that the correction table “assigns a correction factor...” is a recitation of intended use and has not been given patentable weight.

Regarding claim 21, Cooke discloses a source of radiation (col. 3, lines 40-41), and a detector **12** (Fig. 1; 43-52).

9. Claims 1, 9-12, 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by **Vernon (US 2005/0109958 A1)**.

Regarding claim 1, Vernon discloses a method comprising: digitally sampling the analog pulse at a plurality of spaced sampling intervals to generate a set of digital samples (0017, 0032); determining an integral from the samples in the set (0034); selecting a subset of the samples (0026); determining a correction factor corresponding to the subset of samples (0024-0025); and applying the correction factor to the integral to generate a corrected integral value (0032-0035).

Regarding claim 9, Vernon discloses using the subset of digital samples to form a correction face look up table (0031).

Regarding claim 10, Vernon discloses normalizing each of the samples in the subset to a maximum sample in the set of samples to form a normalized sample; and multiplying each of the normalized samples by a factor which is the same for all samples in the subset (0026-0032).

Regarding claim 11, Vernon discloses determining a start time of the analog pulse from the subset of digital samples (0024-0025).

Regarding claim 12, Vernon discloses a generating a correction table which assign a correction factor for a plurality of codes, each of the codes corresponding to a relationship between the subset of sample in a calibration signal which is similar in shape to the analog pulse (0026-0031).

Regarding claim 18, the Applicant appears to invoke 35 U.S.C. 112, sixth paragraph, as the claim meets the following 3-prong analysis:

- a) the claim limitations must use the phrase “means for”;
- b) the “means for” must be modified by functional language; and
- c) the phrase “means for” must not be modified by sufficient structure, material, or acts for achieving the specified function.

Accordingly, 35 U.S.C. 112, sixth paragraph states that a claim limitation expressed in means-plus-function language “shall be construed to cover the corresponding structure...described in the specification and equivalents thereof.”

Vernon discloses, a system comprising: a means **402** for digital sampling an analog pulse 200 at sampling intervals to generate a set of digital samples **210/212/214**



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(Fig. 2; 0017); a means for determining an integral of the analog pulse from the set of digital samples (0034); a means **410** for selecting a subset **Q1-Q4** of the digital values (Fig. 4; 0026); a means for determining a correction factor from the subset of digital samples (0028-0031); and a means for applying the correction to the integral **400** (0032-0035).

Regarding claim 19, Vernon discloses the means for sampling includes an analog to digital converter 402 (0017, 0034).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CASEY BRYANT whose telephone number is (571)270-1282. The examiner can normally be reached on Monday - Friday, 8am - 5pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Porta can be reached on (571)272-2444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David P. Porta/  
Supervisory Patent Examiner, Art  
Unit 2884

Casey Bryant  
Examiner